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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,770	03/03/2004	Gerhard Schmaus	46347	3212

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EXAMINER

SHIPPEN, MICHAEL L

ART UNIT PAPER NUMBER

1621

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/790,770

**Applicant(s)**

SCHMAUS ET AL.

**Examiner**

MICHAEL L. SHIPPEN

**Art Unit**

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-25 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 7 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5 and 17 is/are allowed.
- 6) ☒ Claim(s) 3,4,10,13-16,18 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                               |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/03/04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Election/Restrictions***

The restriction requirement under 35 USC 121 and applicants' traversal thereof have been carefully considered. Applicants urge that the instant application is the national phase from a PCT application and the restriction requirement should have been made under the "Unity of Invention" standard. Contrary to applicants' assertion, the instant application is not a national stage application. This application was not filed under the provisions 35 USC 371, but rather was filed under 35 USC 111(a) as set forth in 37 CFR 53(b). The fact that the instant application is a continuation of a PCT application does make the instant application a national stage application under 35 USC 371. As such, the requirement as set forth in the original requirement is deemed proper, repeated and made final.

Claims 1 and 7 stand withdrawn from consideration as not reading upon the elected invention.

### ***Claim Rejections - 35 USC § 102<sup>1</sup>***

Claims 3, 4, 6, 10, 13-16, 18, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 2,859,410.

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<sup>1</sup> The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The reference teaches the use of the active agent, 4-methyl-4-phenyl-2-pentanol<sup>2</sup>, as an inhibitor of glycolysis which may be caused by bacteria, fungi or yeast<sup>3</sup>. The active agents of the reference may be applied with various carriers and incorporated in various substances including cosmetics<sup>4</sup>. The active agents of the reference can also be used by applying the compositions to substances wherein these microbial populations are present.

As to the method of use claims, the prior art method of use anticipates the instant claims. First, the claims merely recite controlling microorganisms. The term controlling reads on the inhibiting of glycolysis of microorganisms as taught by the reference. Second, even if the term controlling reads on still other embodiments, the methods are still the same since one carrying out the prior art method would be inherently carrying out the claimed method also, see *Ex parte Novitski*, 26 USPQ2d 1389.

As to the method of composition preparation claims, the method of preparation is the same as taught by the reference regardless of any differences in the intended use of the products.

As to the composition claims, the claims read on the prior art compositions regardless of any intended use.

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<sup>2</sup> See the sixth compound listed in Table 1 of column 6.

<sup>3</sup> See the third full paragraph of column 1 and line 57 of column 4.

<sup>4</sup> See the last full paragraph of column 1, the first full paragraph of column 3, EXAMPLE III, EXAMPLE IV, EXAMPLE V and the 2 percent by weight propylene glycol solution mentioned in the first full paragraph of column 6.

***Claim Rejections - 35 USC § 103<sup>5</sup>***

Claims 3, 4, 6, 10, 13-16, 18, and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 2,859,410. The reference is applied as above.

To the extent the reference does not anticipate the claims, the reference clearly renders the claims obvious. One following the teachings of the reference pointed out above would expect to obtain the results suggested by the reference. As such, various methods and compositions within the purview of the teaching of the instant reference would be obvious to one of ordinary skill in the art. The instant claims read on these obvious embodiments taught by the reference.

Moreover, in addition to the specific active agent, 4-methyl-4-phenyl-2-pentanol, exemplified by the reference, analogues thereof (as well as their use and composition thereof) would be obvious to one of ordinary skill in the art. In the third full paragraph of column 2, the reference suggest that various substituents on the phenyl ring will afford compounds having similar properties. The reference indicates that substituents such as hydrogen, alkyl and chlorine may be on the ring. It would be obvious to one of ordinary skill in the art that these substituents could be interchanged on the prior art active agent

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<sup>5</sup> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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to afford additional active agents possessing a community of properties in common. One would expect these additional agents to be suitable for use in the methods and compositions as taught in the reference. The claims read on these methods and compositions rendering the claims obvious.

***Allowable Subject Matter***

Claims 5 and 17 stand allowed.


Claims 8, 9, 11, 12, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The remaining references are cited as of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **571-273-8300**.

MShippen  
June 16, 2005

  
**MICHAEL L. SHIPPEN**  
**PRIMARY EXAMINER**  
**ART UNIT 1621**